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DOCKET NO.: ISIS-4943

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

Phillip Dan Cook, Andrew Kawasaki

Application No.: 09/996,263

Filing Date: November 28, 2001

For: Sugar Modified Oligonucleotides

Confirmation No.: 3783

Group Art Unit: 1635

Examiner: James Schultz

EXPRESS MAIL LABEL NO: EL 999291442 US
DATE OF DEPOSIT: September 23, 2004

EL 999291442US

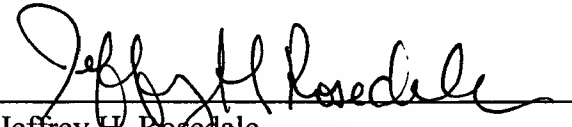
MS Appeal Brief Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF PURSUANT TO 37 CFR § 1.193

Transmitted herewith in triplicate is the REPLY BRIEF in this application with respect to the Examiner's Answer dated **July 29, 2004**.

If any fee is required, please charge Deposit Account No. 23-3050. A duplicate of this transmittal is attached.

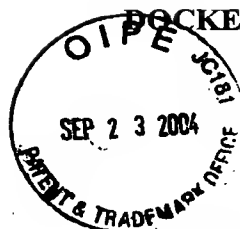
Date: September 23, 2004


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Sir:

APPELLANT'S REPLY BRIEF PURSUANT TO 37 C.F.R. § 1.193

Appellants submit this Reply in response to the Examiner's Answer dated July 29, 2004 in connection with the above-identified application.

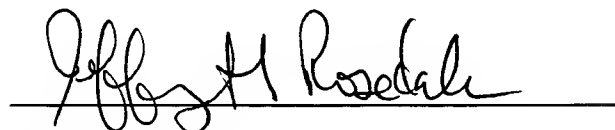
The evidence of record establishes that the 932 Application supports the appealed claims, and the Examiner has failed to proffer any basis for questioning this evidence or otherwise reaching a contrary conclusion. The declaration testimony of Dr. Hecht, for example, establishes that those skilled in the art reading the 932 Application would have recognized Applicants to have had possession of the claimed subject matter as of the application's 1992 filing date (Hecht Dec. ¶13). Although the Examiner does not agree with Dr. Hecht, the Examiner has failed to proffer any evidence or argument sufficient to establish any genuine basis for dispute. Accordingly, the Examiner's denial of Applicants' claim of priority from the 932 Application lacks adequate basis and should be reversed.

The Examiner, for example, appears to have applied an incorrect standard in denying Applicants' claim of priority. The Examiner's reason for denying Applicants' priority claim is that the 932 Application does not expressly state that oligonucleotides according to the instant invention "must comprise" or "must contain" two or more different 2'-modifications

(Answer at pages 8, 10). However, there is no basis for requiring an express disclosure of this type. M.P.E.P. § 2163(II)(A)(3)(b), for example, states that *express, implicit, or inherent* disclosure is sufficient,

The 932 application clearly satisfies this standard. As noted by Dr. Hecht for example, the 932 application expressly discloses a working example of an oligonucleotide having 2'-methylthio and 2'-O-methyl substituents (Hecht Decl. ¶12), and at least implicitly or inherently discloses oligonucleotides having two or more different 2'-sugar modifications and substitutions (*id.*, ¶¶ 11,13). Although the Examiner asserts that certain text in the specification does not support Applicants' claims when read in isolation (Answer at pp. 8-9), this assertion is irrelevant, even if true. Indeed, the test under the first paragraph of §112 is that adequate written description support for an applicant's claim limitation exists even though it was not set forth "*in haec verba*" in the specification. *In re Wright*, 866 F.2d 422, 425, (Fed. Cir. 1989). Here, as noted by Dr. Hecht, it is undisputed that Applicants' disclosure of a specific oligonucleotide having more than one different 2'-modification, coupled with their disclosure of other possible 2'-modifications, provides written description of the claimed subject matter to those skilled in the art (Hecht Decl. ¶13).

Applicants thus have established their priority right of claims 8-13 with respect to the 932 application. Because the filing date of the 932 Application is earlier than the earliest effective filing date of the Draper patent, Applicants request that the rejection of claims 8-13 under 35 U.S.C. §102(b) as allegedly being anticipated by the Draper patent be reversed.



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